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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,104	11/15/2000	Eiichi Sato	B422-143	9652
26272	7590	12/09/2005		
COWAN LIEBOWITZ & LATMAN P.C. JOHN J TORRENTE 1133 AVE OF THE AMERICAS NEW YORK, NY 10036			EXAMINER MOORTHY, ARAVIND K	
			ART UNIT 2131	PAPER NUMBER

DATE MAILED: 12/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/713,104		SATO, EIICHI	
	Examiner		Art Unit	
	Aravind K. Moorthy		2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6,8-10 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6,8-10 and 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the amendment filed on 15 September 2005.
2. Claims 1, 6, 8-10 and 21-24 are pending in the application.
3. Claims 1, 6, 8-10 and 21-24 have been rejected.
4. Claims 2-5, 7 and 11-20 have been cancelled.

Response to Amendment

5. The examiner approves the amendment made to claims 1, 9 and 10. The applicant has amended the claims so that the second discrimination means is discriminating if the address corresponds to stored address. The examiner withdraws claim rejections 35 USC § 112 (2).

Response to Arguments

6. Applicant's arguments with respect to claims 1, 6 and 8-10 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1, 6, 8-10 and 21-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitations "selecting a method of transferring" and "control means for

controlling to transfer the received data by using the method selecting by said selection means”
are not enabled by the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 6, 9, 10, 21 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Ginter et al U.S. Patent No. 6,658,568 B1.

As to claim 1, Ginter et al discloses a communication apparatus for transferring data from a first network to a second network, the apparatus comprising:

first discrimination means for discriminating if the received data is a confidential data [column 58, lines 17-54];

second discrimination means for discriminating if the terminal of an address of the received data corresponds to a stored address [column 90 line 16 to column 91 line 2];

selection means for selecting a method of transferring the received data from a method of transferring the received data attached with E-mail to the terminal, a method of encrypting the received data and transferring the encrypting data attached with E-mail to the terminal or a method of storing the received data in a predetermined memory and transferring information to be used for access to

the stored received data attached with E-mail to the terminal to in accordance with the result of the discrimination by the first discrimination means and the second discrimination means [column 90 line 16 to column 91 line 2]; and

control means for controlling to transfer the received data by using the method selected by the selection means [column 90 line 16 to column 91 line 2].

As to claims 6, 21 and 23, Ginter et al discloses an apparatus further comprising:

management means for managing encryption information correlated to the terminal [column 97 line 63 to column 98 line 51]; and

third discrimination means for discriminating if the encryption information correlated with the terminal is managed by the management means [column 97 line 63 to column 98 line 51],

wherein the control means controls a method of providing the terminal with the received data in accordance with the discrimination results [column 97 line 63 to column 98 line 51].

As to claim 9, Ginter et al discloses a communication method of transferring data from a first network to a second network, the method comprising:

first discrimination means for discriminating if the received data is a confidential data [column 58, lines 17-54];

second discrimination means for discriminating if the terminal of an address of the received data corresponds to a stored address [column 90 line 16 to column 91 line 2];

selection means for selecting a method of transferring the received data from a method of transferring the received data attached with E-mail to the terminal, a method of encrypting the received data and transferring the encrypting data attached with E-mail to the terminal or a method of storing the received data in a predetermined memory and transferring information to be used for access to the stored received data attached with E-mail to the terminal to in accordance with the result of the discrimination by the first discrimination means and the second discrimination means [column 90 line 16 to column 91 line 2]; and

control step of controlling to transfer the received data by using the method selected in the selection step [column 90 line 16 to column 91 line 2].

As to claim 10, Ginter et al discloses a computer readable memory medium storing a program of a communication method of transferring data from a first network to a second network, the apparatus comprising:

first discrimination means for discriminating if the received data is a confidential data [column 58, lines 17-54];

second discrimination means for discriminating if the terminal of an address of the received data corresponds to a stored address [column 90 line 16 to column 91 line 2];

selection step of selecting a method of transferring the received data from a method of transferring the received data attached with E-mail to the terminal, a method of encrypting the received data and transferring the encrypting data attached with E-mail to the terminal or a method of storing the received data in a

predetermined memory and transferring information to be used for access to the stored received data attached with E-mail to the terminal to in accordance with the result of the discrimination by the first discrimination means and the second discrimination means [column 90 line 16 to column 91 line 2]; and

control step of controlling to transfer the received data by using the method selected in the selection step [column 90 line 16 to column 91 line 2].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 8, 22 and 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al U.S. Patent No. 6,658,568 B1 as applied to claims 1, 9 and 10 above, and further in view of Perlman U.S. Patent No. 6,363,480 B1.

As to claims 8, 22 and 24, Ginter et al does not teach management means for managing the encryption information and an effective period of the encryption information correlated with the terminal. Ginter et al does not teach discrimination means for discriminating the effective period of the encryption information and if the encryption information correlated with the terminal which is a destination of the received data is managed by the management means. Ginter et al does not teach that the control means controls a method of providing the received data in accordance with the discrimination results.

Perlman teaches management means for managing the encryption information and an effective period of the encryption information correlated with the terminal [column 6 line 58 to column 7 line 8]. Perlman teaches discrimination means for discriminating the effective period of the encryption information and if the encryption information correlated with the terminal which is a destination of the received data is managed by the management means [column 6 line 58 to column 7 line 8]. Perlman teaches that the control means controls a method of providing the received data in accordance with the discrimination results [column 6 line 58 to column 7 line 8].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Ginter et al so that the destination information in the header would have included encryption information corresponding to the destination was within an effective period. The management system would have determined if the encrypted information correlates with the effective period and if the encrypted information was received by the appropriate destination. The means of providing the information would have been in accordance with the determination of the effective period.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Ginter et al by the teaching of Perlman, as described above, because it permits selection of an appropriate decryptability lifetime for specific units of data, such as electronic mail messages. Further, where one or more third party ephemeralizer systems are used to provide ephemeral keys to encrypt a message, such third party ephemeralizers may be employed to destroy the ephemeral keys at their expiration times, without burdening the communicating parties with this responsibility [column 4, lines 18-27].

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K. Moorthy whose telephone number is 571-272-3793. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2131

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aravind K Moorthy
December 6, 2005

AM

CEL

Primary Examiner

AV 2131

12/7/05